

**REMARKS**

It is respectfully requested that this Preliminary Amendment be entered in the above-identified application prior to continued examination.

Initially, the Applicants would like to thank the Examiner for the indication that claims 9, 11, 14 and 16 are allowable.

However, in the Final Official Action, the Examiner rejected claims 1-8, 10, 12, 13, 15, and 19-22 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application No. 2003/0117491 to Avni et al., (hereinafter "Avni"). Furthermore, the Examiner rejected claims 17 and 18 under 35 U.S.C. § 103(a) as being unpatentable over Avni in view of European Patent No. 0912047 to Matsumoto et al., (hereinafter "Matsumoto").

With regard to Avni, the Examiner argued that the illumination period ( $\Delta T4$ ) can have variable values (citing paragraphs 0075-0076 and Figures 7-9). Applicants respectfully disagree. From the cited portions of Avni, the illumination period ( $\Delta T4$ ) can be set to different values, but once it is set, it does not vary from one image acquisition cycle ( $\Delta T1$ ) to another image acquisition cycle. That is to say, although the illumination period ( $\Delta T4$ ) can be changed, once it is changed, the length thereof remains constant for each image acquisition cycle. Therefore, although Avni teaches changing the length of the illumination period, Avni does not disclose presetting at least two different illuminating conditions and a switching order thereof and switching the illuminating conditions according to a set order.

Furthermore, in the "Response to Arguments" section of the Final Official Action, the Examiner argues that the words "for" and "capable of" does not require that the reference actually teach the recited use, but merely that the device disclosed in the reference is

capable of the use. Although Applicants disagree with the Examiner's arguments and the Examiner has not cited any authority to support such argument, in the interests of advancing prosecution, independent claims 1, 7, 12 and 17-19 have been amended to remove such terms.

In the Advisory Action, the Examiner argues that the features upon which applicant relies (i.e., varying the illumination period from one image acquisition cycle to another image acquisition cycle) are not recited in the claims. In response, independent claims 1, 7, 12 and 17-19 have been further amended to positively recite such features.

The amendments to independent claims 1, 7, 12 and 17-19 are fully supported in the original disclosure. Therefore, no new matter has been entered into the disclosure by way of such amendment.

With regard to the rejection of claims 1-8, 10, 12, 13, 15, and 19-22 under 35 U.S.C. § 102(e), a capsule endoscope apparatus having the features discussed above and as recited in independent claims 1, 7, 12 and 19, is nowhere disclosed in Avni. Since it has been decided that "anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,"<sup>1</sup> independent claims 1, 7, 12 and 19 are not anticipated by Avni. Accordingly, independent claims 1, 7, 12, and 19 patentably distinguishable over Avni and are allowable. Claims 2-8, 13, 15, and 20-22 being dependent upon claims 1, 7, 12, and 19, are thus at least allowable therewith.

With regard to the rejection of claims 17 and 18 under 35 U.S.C. § 103(a), Independent claims 17 and 18 are not rendered obvious by the cited references because neither the Avni patent nor the Matsumoto patent, whether taken alone or in combination,

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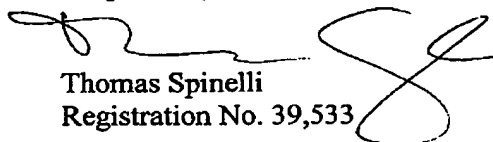
<sup>1</sup> Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

teach or suggest a capsule endoscope apparatus having the features described above.

Accordingly, claims 17 and 18 patentably distinguish over the prior art and are allowable.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



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